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EXAMINER

BOYCE, ANDRE D

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/426,954

Applicant(s)

FUSZ, EUGENE AUGUST

Examiner

Andre Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. This Final Office action is in response to Applicant's amendment filed May 21, 2003. Claims 4, 6, and 14 have been amended. Claims 1, 3-17, 19-26, and 28 are pending.
2. The previously pending rejections to claims 4, 6, and 14 under 35 USC § 112 have been withdrawn.
3. Applicant's arguments filed May 21, 2003 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-17, 19-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (USPN 5,855,008), in view of Kepecs (USPN 6,009,411).

As per claim 1, Goldhaber et al disclose a method for prompting an individual to create an anonymous data profile for the individual (see column 6, lines 40-44), comprising the steps of providing the individual with access to a database (consumer database 120, see column 12, lines 21-24), requesting anonymous profile information, about the individual be entered into the database (see column 12, lines 28-30), and compensating the individual for either or both of entry of the anonymous profile information and feedback provided in response to marketing data (see column 10, lines 46-53). Goldhaber et al does not disclose maintaining the anonymity of the individual through an inability to accept contact information in the profile. Kepecs discloses a method of distributing and redeeming promotions wherein no consumer identification is maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a unique customer key with no other identification data (see column 6, lines 51-53), wherein the consumer is compensated via a discount or credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 3, Goldhaber et al disclose asking the individual a plurality of questions (profile questionnaire, see column 13, lines 32-35).

As per claim 4, Goldhaber et al disclose communicating with the individual via the password (see column 16, lines 58-63).

As per claim 5, Goldhaber et al disclose asking the individual for a multi-character identifier (handle, see column 36, lines 15-19).

As per claim 6, Goldhaber et al disclose asking the individual at least one personal question, wherein the individual is permitted to enter the database only if a correct multi-character identifier (handle, see column 13, lines 15-19) is given and if at least one of the questions is answered correctly (password, see column 13, lines 22-26).

As per claim 7, Goldhaber et al disclose contact information including at least one of a name, a social security number, a telephone number, and an address (see column 13, lines 1-13).

As per claim 8, Goldhaber et al disclose a method for providing advertising feedback (see column 10, lines 39-42), comprising the steps of administering to each individual a password, absent any contact information for the individual, (see column 13, line 22), utilizing the password to access a database (consumer database 120), entering profile information for the individual in the database (see column 12, lines 39-42), storing the entered profile information in the database (see column 13, lines 28-30), presenting at least one of the individuals with a set of data, receiving feedback regarding the set of data (see column 16, lines 16-19), and

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compensating the at least one individual for the feedback (see column 16, lines 19-23). Goldhaber does not disclose maintaining the anonymity of the individual through an inability to accept contact information in the profile. Kepecs discloses a method of distributing and redeeming promotions wherein no consumer identification is maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a unique customer key with no other identification data (see column 6, lines 51-53) , wherein the consumer is compensated via a discount or credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 9, Goldhaber et al disclose presenting each individual with a second set of information generated by an advertiser (see column 10, lines 44-46).

As per claim 10, Goldhaber et al disclose communicating the feedback in aggregate form (through the attention broker in the Goldhaber et al method) to the advertisers (see column 17, lines 4-9).

As per claim 11, Goldhaber et al disclose allowing each individual to choose a multi-character identifier (see column 13, lines 24-26).

As per claim 12, Goldhaber et al disclose asking the individual a plurality of questions (profile questionnaire, see column 13, lines 32-35).

As per claim 13, Goldhaber et al disclose paying the individuals for their feedback with at least one of digital cash, credits, or coupons (see column 10, lines 46-53).

As per claim 14, Goldhaber et al disclose separating the profile information from the set of data and ensuring the advertisers do not obtain the first set information (see column 14, lines 18-20).

As per claim 15, Goldhaber et al disclose presenting each individual with data that is specific to the profile information (consumer profile) provided by the at least one individual (see column 14, lines 30-34).

As per claim 16, Goldhaber et al disclose an apparatus for conveying and storing information relating to anonymous data profiles (see column 6, lines 40-44), comprising a first data repository, a first computer linked to the first data repository (see column 12, lines 39-42), configured to communicate with the first data repository via a password (see column 13, line 22), provide a first set of information about the individual to the first data repository (see column 13, lines 28-30), and a processor programmed to communicate with the first data repository and the first computer (software agents 101, see column 9, lines 53-56). Goldhaber et al disclose a second data repository, a second set of computers linked to the second data repository, the second set of computers configured to provide a plurality of second sets of information to the second data repository (servers 106, see column 9,

lines 62-67), the first data repository separate from the second data repository, the processor (software agents 110) further programmed to communicate with the second data repository and the second set of computers (see column 9, lines 58-61), the processor also programmed to receive and store feedback regarding the second sets of information, and provide compensation data to the first data repository and linked to the first information sets (feedback stored by servers 106 and compensation routed through consumer computer 104). Goldhaber et al do not disclose the first set of information lacking information relating to a name, an address, a telephone number, and a social security number of the individual, through an inability to accept such information into the first computer. Kepecs discloses⁷ distributing and redeeming promotions wherein no consumer identification is maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a unique customer key with no other identification data (see column 6, lines 51-53), wherein the consumer is compensated via a discount or credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 17, Goldhaber et al disclose the processor (software agents 101) further programmed to store the first set of information from the first computer, if the correct password is provided by the first computer (see column 16, lines 58-63).

As per claim 19, Goldhaber et al disclose the second set of computers (servers 106) not being able to access the first data repository (see column 14, lines 37-39).

As per claim 20, Goldhaber et al disclose the processor (software agents 110) further programmed to screen the second set of information and grant access to the screened second set of information by the first computer (consumer computer 104) if the screened second set of information includes at least one attribute compatible with at least one attribute in the first set of information (see column 14, lines 53-56).

As per claim 21, Goldhaber et al disclose the first computer (consumer computer 104) being configured to access the screened second set of information stored in the first data repository (see column 15, lines 34-37).

As per claim 22, Goldhaber et al disclose a system for generating advertising feedback from anonymous consumers via an electronic data communications network (overall environment, see column 9, lines 33-36), comprising a control unit for coupling to the communications network (consumer computers with software agents, see column 9, lines 53-56), a server (servers/attention brokers 106, see column 9, lines 37-38 and 62-63) coupled to the control unit comprising a consumer generated database for storing profile information related to consumers, a marketer database for storing information to be reviewed by consumers, and a processor programmed (software agents 110, see column 9, lines 53-61) to receive consumer

generated data sets controlled by the consumers, each data set including a set of individual characteristics, the processor further programmed to download the consumer generated data sets into the consumer generated database (see column 13, lines 28-30), receive controlled information from marketers, the processor further programmed to download marketer generated data into the marketer database (see column 16, lines 26-29), comparing the marketer generated data set to each consumer generated data set, and if the marketer generated data is identified as matching one or more of the individual characteristics of the consumer generated data sets, designating the marketer generated data set to be communicated to the consumer (see column 16, lines 30-35), the processor also programmed to receive feedback from the anonymous consumers regarding the marketer generated data, the system configured to provide compensation to the anonymous consumers for the feedback (feedback stored by servers 106 and compensation routed through consumer computer 104). Goldhaber et al do not disclose refusing a name, an address, a telephone number, and a social security number of the consumer, and the database having an inability to accept contact information. Kepecs discloses distributing and redeeming promotions wherein no consumer identification is maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a unique customer key with no other identification data (see column 6, lines 51-53), wherein the consumer is compensated via a discount or credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an effective method of marketing products to

potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 23, Goldhaber et al disclose the processor programmed to communicate designated marketer generated data to the consumer if the consumer chooses to view the data (see column 14, lines 53-60).

As per claim 24, Goldhaber et al disclose the processor programmed to communicate the anonymous consumer generated feedback of the designated marketer generated data to the marketer (see column 17, lines 4-9).

As per claim 25, Goldhaber et al disclose the processor further programmed to prevent the marketers from accessing the consumer-generated data sets (see column 14, lines 18-20).

As per claim 26, Goldhaber et al disclose the processor further programmed to accept consumer generated data sets from the consumer if a correct password is received (see column 16, lines 58-63).

As per claim 28, Goldhaber et al disclose the electronic data communications network comprising the Internet (see column 9, lines 33-35).identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, therefore it would

have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

Response to Arguments

6. In the Remarks, with respect to claims 1 and 8, Applicant argues that Goldhaber et al in view of Kepecs does not describe or suggest an inability to accept contact information. Applicant further argues that “not maintaining” implies an inability to store as opposed to an inability to “accept”. The Examiner disagrees with Applicant’s assertions, and respectfully submits that Kepecs discloses the lowest level of security, simply being the key with no other identification (see column 6, lines 52-59). This particular method (embodiment), as disclosed by Kepecs, includes no other contact identification or information, and indeed discloses Applicant’s limitation of “maintaining the anonymity of the individual through an inability to accept contact information in the profile”. Identifying the consumer by the key **only**, includes both an inability to store (i.e., not maintaining), but also an inability to accept. Any other interpretation, inclusion, or acceptance of information would not be included in the “lowest level of identification”, as disclosed by Kepecs. The citation relied on by Applicant, namely column 6, lines 23-26 of Kepecs, refers

to the secure registration level, **not the lowest level of security**. As can be seen, these two different levels cannot be used simultaneously.

With respect to claims 16 and 22, Applicant further argues that Goldhaber et al in view of Kepecs teach away from the invention, since Goldhaber et al recite that an advertiser may pay for consumer names and addresses and Kepecs states that mailing address, social security numbers, and passport numbers as part of a database. The Examiner disagrees with this assertion and submits that Kepecs indeed teaches the inability to accept contact information, as seen in the "lowest level of identification". As a result the combination of Goldhaber et al, in view of Kepecs does not teach away from the apparatus of claim 16 and the system of claim 22.

Lastly, Applicant argues that there is no suggestion to combine the references. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kepecs teaches the inability to accept contact information, as seen in the "lowest level of identification". Further, Goldhaber et al disclose private profiles, that **may** provide contact information (see column 12, lines 21-22). Alternatively, contact information **may not** be provided. This alone provides motivation to combine the references, not to

mention that both Goldhaber et al and Kepecs are concerned with an effective method of marketing products to potential consumers.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-

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9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



adb
August 4, 2003

Susanna Diaz
Susanna Diaz
Primary Examiner
A.U. 3623